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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,067	12/01/2003	Michael Dreja	H 5118 PCT/US	2749

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EXAMINER

METZMAIER, DANIEL S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,067	<b>Applicant(s)</b> DREJA ET AL.	
	<b>Examiner</b> Daniel S. Metzmaier	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on See Detailed Action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-60 is/are pending in the application.
- 4a) Of the above claim(s) 56-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/2/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 28-60 are pending.

This Action is responsive to the papers filed 12/1/2003; 8/2/2004; 2/13/2006; and 5/15/2006.

Applicants filed an amendment to the claims on December 1, 2003, directing the cancellation of claims 2-27 and listing claim 1 in German. While said amendment is non-compliant, said amendment is made moot and superseded by the preliminary amendment filed August 2, 2004, canceling claims 1-27 and presenting new claims 28-60.

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 28-55, and the species of (1) cyclodextrins as the carrier molecules, (2) perfumes as the active substances, (3) tetramethyl orthosilicate as the sol/gel precursors, and (4) a gel matrix as the composition form in the reply filed on May 15, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 28-55 are generic to at least one of the elected claim elements.

2. Claims 56-60 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 13 and May 15, 2006.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 28-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed processes are vague and indefinite since it is unclear what is intended by executing a "sol/gel process". It is unclear whether the claims require a "sol/gel precursor" or whether the carrier may provide both the function of carrier and sol/gel precursor or gel forming material that function in the "sol/gel process".

It is unclear whether "active" modifies only "substances" or is intended to modify also "components". It is unclear what said "active substances" are "active".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 28-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizukami et al, US 4,781,858. See entire reference, particularly the abstract; column 1,

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lines 7 et seq, particularly 20 et seq; columns 3-4, lines 56-10; examples and claims.

While Mizukami et al does not explicitly set forth the porosity of the materials, (a) the claims do not quantify said porosity and (b) the process is anticipated. Since the process is anticipated, the porosity of the resulting materials formed from said process would be expected to have the same properties and inherent to the process and the materials employed.

8. The following rejection is based on the physical properties, which the record does not provide any evidence that the process is distinguished based on the properties and/or the elected species to the incorporation of perfumes.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 28-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizukami et al, US 4,781,858, optionally in view of Nebashi et al, US 4,992,198.

Mizukami et al (see entire reference, particularly the abstract; column 1, lines 7 et seq, particularly 20 et seq; columns 3-4, lines 56-10; examples and claims) discloses cyclodextrin-silica composites formed by (examples) a sol/gel process and incorporating an active agent, such as enzymes or agricultural materials.

To the extent Mizukami et al differs from the claims in the incorporation of perfumes in the compositions or the order of addition of the agent to the cyclodextrin, it would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ perfume as an obvious clathrate materials clearly contemplated in the Mizukami et al references as shown by the Nebashi et al reference. Furthermore, the "selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results". See MPEP 2144.04.

Mizukami et al (column 1, lines 20 et seq; column 2, lines 40 et seq) disclose the use of clathrate forming cyclodextrin for incorporating agents into a cyclodextrin-silica composite. Mizukami et al (columns 2-3, lines 62-3) discloses examples of materials that may be incorporated into the cyclodextrin-silica materials including enzymes and agricultural materials as examples. Mizukami et al clearly contemplates materials known to form clathrates with cyclodextrins.

Nebashi et al (abstract; column 2, lines 35 et seq; column 3, lines 18 et seq) disclose perfume-cyclodextrin clathrates.

These references are combinable since they teach cyclodextrin clathrate compositions. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ perfume as an obvious clathrate materials clearly contemplated in the Mizukami et al references as shown by the Nebashi et al reference.

To the extent the porosity or the physical properties of the materials resulting from the Mizukami et al process differ from the claims, some variation in properties of the materials resulting from the processes of Mizukami et al would have been expected based on the materials and the process conditions. Applicants have not shown said properties to distinguish the otherwise anticipated process. See MPEP 2112.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining art cited in applicants IDS, which corresponds to the references cited in the search report, are cumulative or less pertinent than those relied on above for the elected species and the exemplified and claimed invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM